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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,605	04/19/2001	Tung Quang Le	5624.3-1	3508
23559	7590	11/24/2004	EXAMINER	
MUNSCH, HARDT, KOPF & HARR, P.C. INTELLECTUAL PROPERTY DOCKET CLERK 1445 ROSS AVENUE, SUITE 4000 DALLAS, TX 75202-2790			IYER, RAMAKRISHNA R	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/838,605	Applicant(s) LE ET AL.	
	Examiner Raju Iyer	Art Unit 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/19/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/19/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Referenced NPL document</u> |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - i. In Table A on page 12, the terms "ghz" and "GHz" are both used to signify Gigahertz. GHz is the preferred terminology.
 - ii. On page 13, the description of Fig. 5 (lines 27-29) is incomplete. For example, descriptions of boxes 370A, 370B etc., and lines 340, 345, and the symbols Lambda 1 etc. are not provided.

Appropriate correction is required.

Claim Objections

2. Claim 16 is objected to because of the following informalities: letter "e" in the word "The" is missing. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It claims a "data protocol" which does not fall under any of the categories listed in 35 U.S.C. 101.

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5. Claims 2 -10 are rejected under 35 U.S.C. 101 because they are all directly or indirectly dependent on Claim 1 which is rejected under 35 U.S.C. 101 as stated above (paragraph 4).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-2, 8 -12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Internet Engineering Task Force document RFC 792, "Internet Control message Protocol" by J. Postel ("Postel"), in view of US Patent Number 6,735,215 ("Cao").

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9. Regarding Claim 1, Postel in his publication on Internet Control Message Protocol (ICMP) discloses an "Echo or Echo Reply" message containing a source field for providing the address of a first node and an echo field for providing the address of the destination node (pages 14 and 15). Postel teaches that the identifier field in the message "might be used like a port in TCP or UDP to identify a session".

Postel, in his disclosure, does not specifically describe the use of the message for "provisioning a communications link".

Cao in his invention, discloses a system and method for "automatic determination of port identities in a heterogeneous telecommunications system" (Col. 1 lines 9-10), wherein a network element initiates a "port interconnectivity discovery process by sending a recognition request message" and "awaits an acknowledgement signal from the receiving network element". (Col. 2, lines 36-51). Cao discloses further that the recognition and acknowledgement messages include the address of each of the network elements as well as the specific identity of the ports involved in the communication (Col. 7, lines 10 - 25 and lines 39 - 54).

A person of ordinary skill in the art would have been motivated to employ Cao in Postel, since there is a strong motivation in the telecommunications industry to make network management protocols compatible with the Internet Protocol (IP) and offer web-based network management tools including automatic network provisioning as a capability in telecommunications networks. Since ICMP is an integral part of IP (e.g. see Postel, page 1), a person of

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ordinary skill in the art would have been motivated to structure the data protocol disclosed by Cao into the format taught by Postel.

At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains, to combine Postel with Cao (collectively "Cao-Postel") to obtain the invention as specified in Claim 1.

10. Regarding Claim 2, Cao-Postel disclose all the limitations of the claim as applied to Claim 1 above (paragraph 9), and further, Cao teaches that the network element address and specific port information should be included in the recognition request and recognition detected messages (Col. 7, lines 10-54).

11. Regarding Claim 8, Cao-Postel disclose all the limitations of the claim as applied to Claim 1 above (paragraph 9), and further, Cao discloses that his invention applies to a Synchronous Optical Network (SONET) comprising multiple optical network nodes (Col. 1, lines 45-48; Col. 2, lines 16 - 19).

12. Regarding Claims 9 and 10, Cao-Postel disclose all the limitations of the claim as applied to Claim 1 and Claim 8 above (paragraphs 9 and 11).

13. Regarding Claim 11, Cao-Postel disclose all the limitations of the claim as applied to Claim 1 and Claim 8 above (paragraphs 9 and 11), and further, Postel

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teaches that in order "to form an echo reply message, the source and destination addresses are simply reversed" (page 14).

14. Regarding Claims 12, 18 and 19, Cao-Postel disclose all the limitations of the claim as applied to Claim 1, Claim 8 and Claim 11 above (paragraphs 9, 11 and 13).

Allowable Subject Matter

15. Claims 13 – 17, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see attached sheet).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raju Iyer whose telephone number is (571) 272 6047. The examiner can normally be reached on 7.30 a.m. - 4.00 p.m. on all weekdays except every other Friday.

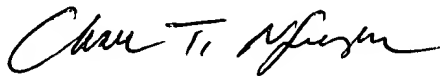
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272 3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raju Iyer



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600